

**Appl. Ser. No. 09/504,070**

**Att. Docket No. 10746/16**

Reply to Office Action of September 29, 2003

**REMARKS**

Claims 1 to 71 are canceled without prejudice, claims 72 to 116 are added, and therefore claims 72 to 116 are now pending.

Applicants respectfully request reconsideration of the present application in view of this response.

Applicants thank the Examiner for considering the Information Disclosure Statements, PTO-1449 forms and related references.

New claims 72 to 116 do not add any new matter and are supported in the specification. Claims 72 to 116 are allowable for the reasons discussed herein.

With respect to paragraph one (1) of the Office Action, the statement is not understood since the present application does contain an Abstract of the disclosure. *A copy of the originally filed Abstract is enclosed* for the Examiner.

With respect to paragraph two (2), The requirement to submit a substitute specification is respectfully traversed. In this regard, it is believed and respectfully submitted that the present specification fully complies with Rules 52(a) and 52(b). The Application has been reviewed, and it is not understood how the specification is not a proper English translation. If the Office insists on a Substitute Specification, it is respectfully requested that the Office specifically identify how the present application does not satisfy the statutory and rule requirements, since no examples were provided in the Office Action.

It is also noted that the assignee of the present application has previously submitted many cases that were considered proper. It is not understood how the present application does not satisfy any specific statutory or regulation requirements, and it is therefore not understood what would be changed. It is therefore respectfully requested that the Substitute Specification requirement be withdrawn.

With respect to paragraph four (4), claims 1 to 71 were rejected under the second paragraph of 35. U.S.C. § 112 as indefinite.

While the indefiniteness rejections may not be agreed with, to facilitate matters, claims 1 to 71 have been canceled without prejudice, and claims 72 to 116 have been added. It is believed and respectfully submitted that the present claims are definite. As to "circulation system (method)" in the new claim 86, for example, it is believed that "data circulation" is clear and definite, especially to a person having ordinary skill in view of the specification. If

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the Examiner believes that another word instead of "circulation" is appropriate, any suggestions are welcomed, as provided for by the M.P.E.P. It is therefore respectfully requested that the indefiniteness rejections be withdrawn as moot.

With respect to paragraph seven (7), claims 1 to 71 were rejected under 35 U.S.C. § 102(b) as anticipated by Samson, U.S. Patent No. 5,287,408.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter, as discussed herein. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine must fail absent the foregoing conditions.

While the anticipation rejections may not be agreed with, including in view of the foregoing, to facilitate matters and to better clarify the claimed subject matter.

In this regard, it is believed that "Samson" refers to an apparatus and method of disabling an unauthorized copy of a computer program, in which a dedicated computer program is used to generate a particular set of license numbers. As understood, a separate program embeds the license numbers into valid copies of the computer program, and the computer program also includes a section for verifying its license number. When a program is attempted to be run, the validation procedure verifies the license number. If the license

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number does not have the uncommon mathematical property, an error message is generated and the program exits. Accordingly, "Samson" does not identically describe (or even suggest) the features of newly added claims in which the manifest and the accreditation information are sent to the user apparatus from the issuer apparatus, or any analogous features in the new independent claims.

In particular, for example, claim 72 is directed to a data storing method of storing digital information which has a value, the data storing method is used in a system including an issuer apparatus issuing the digital information and a user apparatus, the method comprising: adding, by the issuer apparatus, a signature to the digital information; generating, by the issuer apparatus, a manifest corresponding to the digital information; generating, by the issuer apparatus, accreditation information with the signature, and *sending the digital information with the signature and the accreditation information with the signature to the user apparatus*, wherein the accreditation information indicates third parties that are trusted by the issuer apparatus and that trust the user apparatus; receiving, by the issuer apparatus, session information from the user apparatus, and sending information that includes the manifest and the session information, to the user apparatus; and verifying, by the user apparatus, the manifest and the session information, and storing the manifest in the user apparatus only when the manifest and the session information are verified.

Independent claim 73 includes an analogous feature to that of claim 72 and is therefore allowable for essentially the same reasons as claim 72.

Claims 74 to 77 depend from claim 73, and are therefore allowable for the same reasons as claim 73.

Independent claims 77, 78, 79 and 80 include analogous features to that of claim 72 and are therefore allowable for essentially the same reasons as claim 72.

Claims 81 to 83 depend from claim 80, and are therefore allowable for the same reasons as claim 80.

Independent claims 84 and 85 include analogous features to that of claim 72 and are therefore allowable for essentially the same reasons as claim 72.

Independent claim 86 is directed to an original data circulation method in an original data circulation system for storing or circulating original data which is digital information, the method comprising: *sending, by a first apparatus, originality information to a second*

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*apparatus, the originality information including a fingerprint corresponding to a source apparatus of the original data and second information corresponding to the original data, and performing an authentication step of identifying and authenticating, by the second apparatus, the source apparatus, verifying whether the source apparatus is the same as an apparatus corresponding to the fingerprint, and determining that the originality information is valid if the source apparatus is the same as an apparatus corresponding to the fingerprint.* It is respectfully submitted that these features are not identically described (or even suggested) by the "Samson" reference.

Claims 87 to 90 depend from claim 86 and are therefore allowable for the same reasons as claim 86.

Claim 91 includes features like those of claim 86, and is therefore allowable for essentially the same reasons as claim 86.

Claims 92 to 95 depend from claim 91 and are therefore allowable for the same reasons as claim 91.

New independent claim 96 is directed to an issuer apparatus in an original data circulation system for storing or circulating original data which is digital information, the issuer apparatus comprising: *originality information generation means for generating originality information which includes a fingerprint corresponding to the issuer apparatus and second information corresponding to the original data; and originality information sending means for sending the originality information.* It is respectfully submitted that these features are not identically described (or even suggested) by the "Samson" reference.

Claims 97 to 98 depend from claim 96 and are therefore allowable for the same reasons as claim 96.

Claim 100 includes features analogous to those of claim 96, and is therefore allowable for essentially the same reasons as claim 96.

Claim 101 depends from claim 100 and is therefore allowable for the same reasons as claim 101.

Independent claim 102 is directed to a collector apparatus in an original data circulation system for storing or circulating original data which is digital information, the collector apparatus comprising: *identifying means for identifying a source apparatus of originality information; authentication means for authenticating the source apparatus; and*

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*data processing means for performing a process corresponding to the original data if the authentication means determines that the originality information which is sent to the collector apparatus is valid.* It is respectfully submitted that these features are not identically described (or even suggested) by the "Samson" reference.

Claim 103 depends from claim 102 and is therefore allowable for the same reasons as claim 102.

Independent claim 104 is directed to an original data circulation system for storing or circulating original data which is digital information, the original data circulation system comprising: *an issuer apparatus which includes means for generating originality information and sending the originality information, the originality information including a fingerprint corresponding to the issuer apparatus and second information corresponding to the original data; a user apparatus which includes means for verifying validity of a source apparatus of the originality information and means for storing the originality information when the validity is verified; and a collector apparatus which includes means for verifying validity of a source apparatus of the originality information and data processing means for performing a process on the original data if the validity is verified.* It is respectfully submitted that these features are not identically described (or even suggested) by the "Samson" reference.

Claim 105 includes features analogous to those of claim 72, like the claims discussed above, and is therefore allowable for essentially the same reasons as claim 72.

Claims 106, 107 and 108 depend from claim 105 and are therefore allowable for the same reasons as claim 105.

Claim 109 includes features analogous to those of claim 96, and is therefore allowable for essentially the same reasons as claim 96.

Claims 110, 111 and 112 depend from claim 109 and are therefore allowable for the same reasons as claim 109.

Independent claim 113 is directed to a computer readable medium storing program code for causing a computer in an original data circulation system to store or circulate original data which is digital information, the computer being used as a user apparatus, the computer readable medium comprising: *originality information sending program code means for sending originality information which includes a fingerprint corresponding to a source apparatus of the original data and second information corresponding to the original data;*

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*identifying program code means for identifying the source apparatus of the originality information; authentication program code means for determining that the originality information is valid if the source apparatus is authenticated and an apparatus corresponding to the fingerprint and the source apparatus are the same; and storing program code means for storing the originality information if the authentication program code means determines that the originality information is valid.* It is respectfully submitted that these features are not identically described (or even suggested) by the "Samson" reference.

Claim 114 depends from claim 113 and is therefore allowable for the same reasons as claim 113.

Independent claim 115 is directed to a computer readable medium storing program code for causing a computer in an original data circulation system to store or circulate original data which is digital information, the computer being used as a collector apparatus, the computer-readable medium comprising: *identifying program code means for identifying a source apparatus of originality information; authentication program code means for authenticating the source apparatus; and data processing program code means for performing a process corresponding to the original data if the authentication program code means determines that the originality information which is sent to the collector apparatus is valid.* It is respectfully submitted that these features are not identically described (or even suggested) by the "Samson" reference.

Claim 116 depends from claim 115 and is therefore allowable for the same reasons as claim 115.

In summary, it is respectfully submitted that all of claims 72 to 116 of the present application are allowable at least for the foregoing reasons.

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CONCLUSION

In view of the foregoing, it is believed that the objections and rejections have been obviated, and that claims 72 to 116 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,

KENYON & KENYON

Dated: \_\_\_\_\_

1/14/2004

By: \_\_\_\_\_

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